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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,085	03/11/2004	Barry N. Gellman	10124/01201	5328
36636 7590 12/04/2009 FAY KAPLUN & MARCIN, LLP 150 BROADWAY, SUITE 702 NEW YORK, NY 10038				
EXAMINER				
NGUYEN, VI X				
ART UNIT		PAPER NUMBER		
3731				
MAIL DATE		DELIVERY MODE		
12/04/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/798,085

Applicant(s)

GELLMAN ET AL.

Examiner

Victor X. Nguyen

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-6,8,9 and 11-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-6,8,9 and 11-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This Office Action is in response to communication filed on 4/8/2009.

Claims 1, 3-6, 8, 9 and 11-18 remain pending in this application.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 16 recites "wherein the electrode" in lines 13-14. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-5, 8, 9, 11-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Edwards et al US 5,607,389.

Claim 1: Edwards et al disclose a first placeholder element 312 insertable through tissue to a first selected location in a patient's body, the first placeholder element 312 including a first lumen extending there through to a distal opening which, when the first placeholder element is in the first selected location is adjacent to target tissue; a handle (the combination of items 276,

300) including a channel extending there through for receiving the first placeholder element 312, the channel directing elements inserted therein to the first lumen, the handle being removably (fig. 6) coupled to the first placeholder element so that the first placeholder element may be left in the first selected location; a tissue sampling element 6 insertable to the first selected location via the first lumen for obtaining a sample of tissue from the first selected location, the tissue sampling element being removable first lumen while leaving the first placeholder element 312 at the first selected location; and wherein a tissue treatment element 294 insertable to the first selected location via the first lumen.

Claims 3-4: Edwards et al disclose wherein the handle includes a sampling element actuator 10 for operating the tissue sampling element when the tissue sampling element has been inserted there through to the first lumen, and wherein the handle further comprises a sampling safety lock 12 which, when in a locked configuration, prevents actuation of the sampling element actuator.

Claims 5, 8, 12: Edwards et al disclose a second placeholder element 318, a first luer 24 attachment for coupling the first placeholder element to the channel, and wherein the tissue sampling element comprises a second luer attachment 26 for coupling the tissue sampling element to the channel.

Claims 9, 11: Edwards et al disclose the sampling element comprises a biopsy needle (see col. 3, lines 50-67), and wherein the biopsy needle includes a suction lumen for applying suction to a sample of tissue for removal of the sample from the body (see col. 4, lines 30-40).

Claims 13-14: Edwards et al disclose the tissue sampling element further comprises an in-vivo tissue treatment device (see col. 8, lines 35-50), and wherein the tissue treatment element 294 is insertable through the first lumen of the first placeholder element when the first placeholder element 312 is separate from the handle 276,300.

Claims 15, 17-18: Edwards et al disclose the tissue treatment element comprises one of a monopolar and a bipolar electrode (see col. 9, lines 3-7), wherein the tissue treatment element 294 comprises a conduit for insertion of a chemical treatment substance to the first selected location. It is noted that the statement of intended use and other functional statements have been considered but are deemed not to impose any structural limitations on the claims distinguishable over Edwards reference which is capable of being used as claimed if one desires to do so; and wherein the tissue treatment element is coupleable to a source of electric power and employs the first placeholder element as an electrode (see col. 9, lines 3-7).

Claim 16: Edwards et al disclose a first placeholder element 312 insertable through tissue to a first selected location in a patient's body, the first placeholder element including a first element guide (fig. 7); a handle 276, 300 including a channel extending there-through for receiving the first placeholder element, the channel directing elements inserted therein to the first element guide; a tissue sampling element 6 insertable to the first selected location via the first element guide for obtaining a sample of tissue from the first selected location, the tissue sampling element being removable from the first element guide while leaving the first placeholder element at the first selected location; and a tissue treatment element 294 insertable to the first selected location via the first element guide, the tissue treatment element being

insertable through the first element guide when the first placeholder element 312 is separate from the handle, wherein an electrode is a multi-barbed electrode 442, 444.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Edwards et al in view of Milliman et al US 6,213,957.

Edwards et al disclose the invention substantially as claimed except for the placeholder elements comprise markings. Milliman teaches the placeholder elements comprise markings 601. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Edwards by constructing the device with markings as taught by Milliman in order to insert precisely and bring the working components of such minimally invasive instrument to precise location to conduct the desired procedure.

Response to Arguments

5. Applicant's arguments filed on 4/8/2009 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor X. Nguyen whose telephone number is (571) 272-4699. The examiner can normally be reached on M-F (8-4.30 P.M).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Victor X Nguyen/
Examiner, Art Unit 3731

/Anhtuan T. Nguyen/
Supervisory Patent Examiner, Art Unit 3731
12/02/09